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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,680	12/08/2000	Martin Adamczewski	Mo-6000/LcA 34,147	2900

157 7590 03/21/2002

BAYER CORPORATION
PATENT DEPARTMENT
100 BAYER ROAD
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EXAMINER

SCHNIZER, RICHARD A

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 03/21/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/732,680	ADAMCZEWSKI ET AL.	
	Examiner	Art Unit	
	Richard Schnizer	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 23-44 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

An preliminary amendment was received and entered as Paper No. 7 on 12/8/00.
Claims 1-22 were canceled and claims 23-44 were added as requested.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 23-30, 34, and 40, drawn to nucleic acids, e.g. SEQ ID NO:1 or fragments or homologues thereof, classified in class 536, subclass 23.5.
- II. Claims 31-33, drawn to polypeptides, classified in class 530, subclass 350.
- III. Claim 35, drawn to an antibody, classified in class 530, subclass 387.1.
- IV. Claims 36-39, drawn to a transgenic animal and a method of making it, classified in class 800, subclass 21.
- V. Claim 41, drawn to a promoter, classified in class 536, subclass 24.1.
- VI. Claims 42 and 43, drawn to methods of screening compounds which alter the conductive properties of acetylcholine receptors, classified in class 435, subclass 7.21.
- VII. Claim 44, drawn to a method of screening compounds that alter the expression of an acetylcholine receptor gene, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

The nucleic acids of group I are related to the polypeptides of group II because the nucleic acids encodes the polypeptides. The nucleic acids have utility for the recombinant production of the protein in a host cell. Although the nucleic acids and the polypeptides are related, since the nucleic acids encode the specifically claimed polypeptides, they are distinct inventions because the polypeptide products can be made by other and materially distinct processes, such as purification from natural sources. Further, nucleic acids can be used for processes other than the production of proteins, such as nucleic acid hybridization assays.

The nucleic acids of group I and the antibodies of group III are related because the nucleic acids encode the cognate antigens of the antibodies. However, the nucleic acids are not directly necessary for antibody production, and the nucleic acids and antibodies are wholly different compounds having different compositions and functions. Therefore, these inventions are distinct.

The nucleic acids of group I is related to the transgenic animal of group IV because the nucleic acid can be used to produce the transgenic animal. The inventions are distinct because the nucleic acid may be used for other purposes, such as the production of the encoded polypeptide in vitro, or as a hybridization probe.

The nucleic acids of group I are related to the promoter of group V only in that the promoter may be used to drive expression of the nucleic acids in insect cells. The inventions are distinct because the nucleic acids may be expressed under the control of other promoters in, e.g. animal or prokaryotic cells, and the promoter may be used to drive expression of other nucleic acids.

The nucleic acids of group I are related to the methods of groups VI and VII because the nucleic acids may be used in these methods for the production of the

encoded proteins. The inventions are distinct because the nucleic acids have other uses such as probes in hybridization assays.

The polypeptides of group II are related to the antibodies of group III because the polypeptides can be used for the production of the antibodies. The polypeptides are a distinct invention because they can be used in other processes which are materially different from the production of antibodies. For example, the polypeptides can be used to produce cyclic AMP. Further, a protein and its cognate antibody are structurally and functionally distinct molecules with different amino acid compositions.

The polypeptides of group II are related to the transgenic animal of group IV only in that the transgenic animal may produce the polypeptides. The inventions are distinct because the polypeptide can be produced by other means, such as expression in vitro.

The polypeptides of group II are unrelated to the promoter of group V. The two inventions are structurally and functionally distinct are not disclosed as being capable of use together.

The polypeptides of group II are related to the methods of groups VI and VII because the polypeptides may be used in the methods. The inventions are distinct because the polypeptide can be used for other purposes such as the production of antibodies.

The antibody of group III is unrelated to the transgenic animal of group IV, the promoter of group V, or the method of screening compounds of group VI. The antibody is not produced by the animal or the method, is structurally and functionally distinct from both the animal and the promoter, and is not disclosed as capable of use with the method.

The antibody of group III is related to the method of group VII because it may be used to measure the amount of gene expression in the method by quantitating the

resulting protein. The inventions are distinct because the antibody is not required by the method. For example, gene expression could be measured by mRNA quantitation.

The transgenic animal of group IV is unrelated to the insect promoter of group V because it is structurally and functionally distinct, and because the two compositions are not disclosed as capable of use together.

The animal of group IV is related to the methods of groups VI and VII only in that it could serve as a source of cells for these methods. The inventions are distinct in that the methods need not use cells from the animal, but could be performed using cultured cells from a variety of sources.

The promoter of group V is related to the methods of groups VI and VII because it could be used in the method for expression of acetylcholine receptors. The inventions are distinct because the methods do not require the promoter of group V, and other promoters could be used.

The methods of groups VI and VII are unrelated because they have different modes of operation as evidenced by their different method steps, they result in different effects, and they are not disclosed as capable of use together.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification and their recognized divergent subject matter, and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.

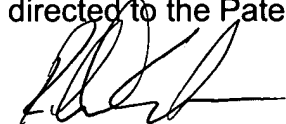
Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Richard Schnizer, whose telephone number is 103-306-5441. The examiner can normally be reached Monday through Friday between the hours of 6:20 AM and 3:50 PM. The examiner is off on alternate Fridays, but is usually in the office anyway.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Leguyader, can be reached at 703-308-0447. The FAX numbers for art unit 1632 are 703-308-4242, and 703-305-3014. Additionally correspondence can be transmitted to the following RIGHTFAX numbers: 703-872-9306 for correspondence before final rejection, and 703-872-9307 for correspondence after final rejection.

Inquiries of a general nature or relating to the status of the application should be directed to the Patent Analyst Trina Turner whose telephone number is 703-305-3413.



Richard Schnizer, Ph.D.